

REMARKS

Claims 1-5 and 11-20 are currently pending in this application. By this response to the non-final Office Action dated June 24, 2009, claims 1, 11, and 16-20 are amended. Support for the amendments is found in the specification and claims as filed. No new matter has been introduced. Favorable reconsideration of the application in light of the foregoing amendments and following comments is respectfully solicited.

I. Telephone Interview of September 17, 2009

Applicant thanks the Examiner for conducting a telephone interview with the undersigned. In the interview the Examiner indicated that claims 1, 11, and 16, as presented above, overcome the rejections under Sections 101 and 112.

II. Rejection Under 35 U.S.C. § 101

On page 2 of the Office Action, claims 1-5 and 16-20 were rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicants respectfully traverse.

As noted in Applicants' last response, the Federal Circuit recently rendered the Bilski decision, which related to the eligibility of method claims under Section 101. Subsequent to this decision, on August 24, 2009 "Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101" (Interim Guidelines) were released. It was indicated that the new guidelines "supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP 2105(IV), 2106.01 and 2106.02." Applicants respectfully refer the Examiner to these guidelines.

Regarding claims 1-5, the Office Action asserts the claims are ineligible because “there is no positive recitation of a particular machine.” Section II.B of the Interim Guidelines explains:

For computer implemented processes, the “machine” is often disclosed as a general purpose computer. In these cases, **the general purpose computer may be sufficiently “particular” when programmed to perform the process steps. Such programming creates a new machine** because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. To qualify as a particular machine under the test, **the claim must clearly convey that the computer is programmed to perform the steps of the method** because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions. . . .

(emphasis added)

Thus, the method of claim 1, in which the recited steps “are performed by a computer programmed to perform the above steps,” recites a “particular machine” which satisfies the *Bilski* “machine-or-transformation” test for Section 101 eligibility. In the interview discussed above, the Examiner agreed that amended claim 1 complies with Section 101.

Regarding claims 16-20, the assertion made in the Office Action that the claims “do not appear to provide a useful concrete and/or tangible result” appears to reflect the State Street test for eligibility that was expressly abandoned by the Federal Circuit in the *Bilski* decision, as noted in Applicants’ previous response. Section II.A.(c) of the Interim Guidelines expressly indicates that “a non-transitory, tangible computer readable storage medium *per se* . . . would be patent-eligible subject matter. . . . The claim as a whole remains a tangible embodiment and qualifies as a manufacture.” Accordingly, Applicants respectfully submit that claim 16, which recites a “computer readable storage medium,” is a patent-eligible manufacture under Section 101. In the interview discussed above, the Examiner agreed that amended claim 1 complies with Section 101.

For at least the above reasons, and in view of the interview conducted with the Examiner, Applicants respectfully submit the claims are eligible for patenting under Section 101, and request withdrawal of the rejection under Section 101.

III. Rejection Under 35 U.S.C. § 112, Second Paragraph

On page 3 of the Office Action, claims 1-5 and 11-20 were rejected under 35 U.S.C. § 112, second paragraph, as “being incomplete for omitting essential steps.” Applicants respectfully traverse.

Independent claims 1 and 16 are amended to recite, *inter alia*, “receiving measurements of an observed electromagnetic field observed outside a scalp.” Independent claim 11 is amended to recite, *inter alia*, “measurement receiving means for receiving measurements of an observed electromagnetic field observed outside a scalp.” In the interview discussed above, the Examiner agreed the claims comply with Section 112. Applicants respectfully request withdrawal of the rejection under Section 112.

III. Conclusion

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner’s amendment, Examiner is requested to call Applicant’s attorney at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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